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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/036,236	03/06/1998	DAVID M. OLIVER	005-905-300	5721

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EXAMINER

AKERS, GEOFFREY R

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/036,236

**Applicant(s)**

OLIVER ET AL.

**Examiner**

Geoffrey Akers

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The Suspension of Action for this application has ended. Accordingly, this application has been examined.
2. Claims 1-82 are pending. Claims 1-82 have been examined.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (see Paper No. 31), or will be included here for clarity, as necessary. The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.
4. As presented in Paper #31 (Non-Final Rejection), Paper #30 presented copies of 3 papers assigning the entire right, title and interest in the invention System For Management Of Transactions On The Suspension of Action for this application has ended. Accordingly, this application Networks, one signed by each inventor. The copy signed by David M. Oliver (dated 07/07/1998) sold and assigned the entire right, title and interest in the invention to Newshare Corporation (the Assignee). Each of the copies signed by William P. Densmore, Jr. (dated 06/05/1998) and Michael J Callahan (dated 07/17/1998) sold and assigned the entire right, title and interest in the invention to Clickshare Service Corporation. PALM records indicate that Newshare Corporation assigned its Assignor interest to Clickshare Service Corporation on 08/13/1998.

***Declaration***

5. Paper #30 also included a Declaration signed by William P. Densmore, Jr. (one of the applicants), dated 12/22/2002, that an enclosure (a memo) was transmitted during 1995 and thereafter to a number of independent third parties, subject to non-disclosure agreement. The memo (which disclosed a copyright date of 1995) is declared to disclose the existence of the applicants' invention in 1995.

6. Paper #32 (in response to the Paper #31) presented a Second Declaration of William P. Densmore, Jr. that presents a compendium of articles published between 18 September 1995 and 23 September 1996, which applicants present to support their claim of priority over Teper et al. (U.S. Patent No. 5,815,665). Examiner has reviewed Paper #32. The declaration has been considered but is ineffective (as explained in the following sections) to overcome the reference: Teper et al., U.S. Patent No. 5,815,665 (filing date of 12/02/1998).

7. The evidence submitted is insufficient to overcome the priority date of the patent reference (Teper et al. [U.S. Patent No. 5,815,665]). Applicants do not claim priority to a specific date. But, rather, the disclosures of applicant are dated disclosures referring to the Clickshare Corporation and/or Newshare Corporation and their activities that, while related to applicants' invention, do not clearly establish due diligence in the prosecution of their invention from a date prior to reduction to practice of the Teper et al.

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reference to either a constructive reduction to practice or an actual reduction to practice of applicants' invention. Various disclosures present dates scattered from 1995 through 2003, with the dates of record as stated in the following paragraphs.

The dates of record in the PALM for U.S. Patent Application No. 09/036,236 are:

- Provisional U.S. Patent application filed: 03/07/1997 (application No. 60/040,223); and
- Nonprovisional U.S. Patent application filed: 03/06/1998.

The Priority date for Teper et al. (U.S. Patent No. 5,815,665) is 04/03/96 (prior art of record).

8. The Manual of Patent Examining Procedure (MPEP) requires, at section 2138.06, that

- The entire period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses.
- Work relied upon to show reasonable diligence must be directly related to the reduction to practice.
- Diligence required in preparing and filing patent application
- End of diligence period is marked by either actual or constructive reduction to practice.

Additional excerpts from the MPEP state:

715.02:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it.

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If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference.

Applicant may overcome a 35 U.S.C 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. However, as discussed above, applicant's 37 CFR 1.131 affidavit must show possession of either the whole invention as claimed or something falling within the claim(s) prior to the effective date of the reference being antedated; it is not enough merely to show possession of what the reference happens to show if the reference does not teach the basic inventive concept.

715.07:

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided.

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

- (A) reduction to practice of the invention prior to the effective date of the reference; or
- (B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D.

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498, 139 O.G. 991 (1st Cir. 1909).

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

715.07(a) Diligence:

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the PTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

Form paragraph 7.62 (reproduced in MPEP § 715) may be used to respond to a 37 CFR 1.131 affidavit where diligence is lacking.

9. In Paper #31, examiner set forth the requirements as stated in the MPEP, see sections 17-20 of Paper #31 (Non-Final Rejection), and reasons for not declaring an interference at that time. Applicants to date have not specifically accounted for the

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entire period during which diligence is required by either affirmative acts or acceptable excuses, work relied upon to show reasonable diligence directly related to the reduction to practice, diligence required in preparing and filing the patent application, and end of the diligence period marked by either actual or constructive reduction to practice.

10. Examiner asserts that the information provided by applicant in the evidence does not provide a disclosure of a continuum of action over time (emphasis added), with specific dates and events that adequately disclose diligence of the inventors or their representative. Additionally, applicants argue that their conception of their invention was before 03 April 1996 (the application date of the Teper et al. patent). To receive benefit of a claimed priority, applicant should identify specific dates of invention for the continuum of action over time from conception to their application for patent (emphasis added).

### ***Priority***

11. Applicants claim priority for a time period beginning before the application date of the Teper et al. patent (see above). Applicants have not submitted/identified a specific timeline for their invention revealing diligence, just dates for some specific actions as disclosed in news releases and the like, e.g.:

- Copyright 1995:
  - Williamsport, Mass., Oct. 23 -- Newshare Corp. begins shipping to selected publishers this week the alpha version of its breakthrough



- Clickshare (SM) system to track and settle Internet-wide micro-transactions;
- Clickshare's personal Newshare(sm) topic-profiling and custom-linking facilities are open for public use . . . and an initial base of Publishing Members will be launched in early 1996;
- Clickshare requires no special software for consumers beyond their Web browser and costs a publisher as little as \$795 to join . . .
- an article dated 09/18/95 that identifies characteristics of the Clickshare system;
- an article dated 10/09/95 that presents a description of some capabilities addressed by the Clickshare system;
- the second Declaration declares that the Clickshare system was experimental at all times at least prior to 03/07/96;
- Applicants state that the Clickshare service was not offered for sale at any time at least prior to 03/07/1996;
- an article dated 03/18/96 that presents a description of some features of the Clickshare system and that technology trials have started;

12. Additionally, applicants have claimed priority through a series of disclosures (see Paper #32), including 2 Declarations by one of the inventors (which include David M. Oliver; William P. Densmore, Jr.; Michael J. Callahan). The Declaration by Mr. Densmore dated 06/26/03 and filed 06/26/03 (in summary) states that:

- a. the Clickshare™ service was experimental at all times at least prior to 03/07/96;
- b. the system was not offered for sale at any time at least prior to 03/07/96;
- c. an article published 09/18/95 presents a description of the Clickshare system;
- d. an article published 10/09/95 presents a description of some capabilities addressed by Clickshare system;
- e. an article published 03/18/96 presents a description of some features of the Clickshare system and that technology trials have started.
- f. the articles indicate that a single user account is maintained, with an anonymous user ID number used to identify users to foreign sites, with a central server for coordination and centralized accounting. They further support the applicants conception of a system having a mechanism for sharing client information and charges among a plurality of service providers, a mechanism for allowing a client registered with one service provider to access services at another service provider, a settling means, and an authentication/verification means.
- g. Applicants state that their invention was made available under an "alpha" test, in which users were able to test compatibility with their internal browsers, and certain aspects of system operation, in order to provide feedback to Newshare (and later Clickshare) regarding the operation of the system and any errors. During this "alpha" test, no content was available for purchase, and no user accounts were charged for per-click access. User registrations, to the extent possible, were

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performed through Clickshare servers, and therefore, no segregation of service provider and on-line provider.

h. Applicants state that the Clickshare™ service was not offered for sale at any time at least prior to 03/07/96. No commercial terms for users, brokers, or service providers were established, and the system was incompletely developed. No mechanism was established prior to 03/07/96 for accepting clients nor customers.

13. Additionally, the following specific disclosures have been identified from a combination of prior art, including applicants' disclosures:

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a. From Paper #32, by Clickshare, last three pages, filed 6/26/03 in Application #09/036,236:

Pg. 1 of 3, dated 6/25/2003, Copyright 1995:

Williamstown, Mass., Oct. 23 -- Newshare Corp. begins shipping to selected publishers this week the alpha version of its breakthrough Clickshare (SM) system to track and settle Internet-wide micro-transactions.

Clickshare's personal Newshare(sm) topic-profiling and custom-linking facilities are open for public use at <http://www.clickshare.com/tryit.html>. Transaction-handling capabilities, and an initial base of Publishing Members will be launched in early 1996.

Clickshare requires no special software for consumers beyond their Web browser and costs a publisher as little as \$795 to join. Publishers can sell information by subscription or per-query to their own users, and set all pricing. Newshare is now soliciting a broader group of "beta" publishers.

Pg. 2 of 3:

"At no time does Clickshare know a user's name or demographic profile." says Oliver. "Only the user's home base publisher has this information."

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Each user has a single "home base" at a Publishing Member (likely to be a local or specialty publication with whom they have a continuing relation). Clickshare users register just once with their home base, providing credit-card information by phone, fax, mail or secure Internet connection. At no time do credit-card numbers or other personal information traverse the Clickshare system.

The Clickshare-enhanced Web Server – which is browser independent – is provided to Member Publishers by Newshare Corp. free under license. Newshare's back-end service network exchanges data with the Internet servers of Clickshare-enabled sites, validating users and tracking all discrete page accesses – chargeable or free – across every participating site.

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b. "Clickshare applauds open market transaction patents as validating technologies based on Internet diversity;" Clickshare; 04 March 2003

pg. 1: "Clickshare's Token Validation Service (TVS), engineered in 1994 and 1995 and subject of a pending patent application, is a compatible and collaborative technology which enables information micropayments, personalization, resource access control and audience measurement. It vests a user with a Digital Calling Card (SM) which can be used for one ID, one password access to multiple web sites. It allows consumers to have credit, but remain anonymous, and respects privacy by requiring no central names database."

"Most important, TVS allows affiliated publishers and consumer billing agents such as ISPs, banks, telcos and retailers to make money – by exchanging users and links just as wholesalers and retailers help each other execute physical commerce."

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c. "Clickshare seeks partners for patent-pending micropayments and user-management technology;" Clickshare; 13 October 1998

A six-month prototype demonstration of the Token Validation Service technology involved nearly 2,000 users. Marketed as the Clickshare Service, TVS was tested with the three publishers: The American Reporter, Studio Briefing and The Christian Science Monitor.

#### **About Clickshare Service Corp.**

Clickshare Service Corp. [www.clickshare.com] was formed in 1997 to acquire technology developed by two affiliated companies, Newshare Corp. and Clickshare Corp. The company is researching ways for publishers to enter the next century by profitably sharing users and information. The TVS/Clickshare technology is the first spinoff of its efforts. Clickshare Service Corp. is privately held and funded and has strategic relationships with Massachusetts Ventures Inc., the Applied

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Computing Systems Institute of Massachusetts Inc., and the University of  
Massachusetts Isenberg School of Management.

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d. "ABOUT CLICKSHARE: Connecting customers with content;" Copyright  
2001.

pg. 2: Clickshare was formed in 1997, completed the development of the  
Clickshare Service version 2.0 in 2000, began rolling out services in the newspaper  
market during 2001, and is connecting information consumers with content in music  
and entertainment. The company acquired patent-pending core technology from two  
predecessor companies. Among original founders was long-time journalist, editor  
and publisher Bill Densmore.

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e. Interactive Age Digital: Daily Media and Marketing Report;"  
Internetweek.com; 07 May 1996

pg. 3: The Christian Science Monitor plans to include 15 years of  
newspaper archives at its soon-to-debut Web site. The venerable paper also  
announced it has picked Clickshare Corp. to provide traffic measurement and  
microtransaction strategies for the site. The Monitor's endorsement is a major boost  
for Clickshare, which has been one of the least hyped of the Web traffic  
measurement companies to date. . . .

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f. "SPECIAL Newshare PUBLISHING MEMBER RATES;" Copyright 1995;  
effective mid-1995.

pg. 1 of 4:... FOR A LIMITED TIME (until our TVS-Token Validation System  
is in place) YOU CAN BECOME A PUBLISHING MEMBERS FOR JUST \$250.00.

pg. 2 of 4:Registration as a Newshare Publishing Member within the  
Newshare Token Validation Service (TVS) (effective mid-1995), enabling the receipt  
of royalty payments for copyrighted content accessed by Newshare members  
worldwide.

pg. 2: COMMISSION Agreement:  
Until the Token Validation Service (TVS) server software is released for public  
use, Newshare Corp. shall be entitled to a commission of five (5) percent on any  
Newshare Publishing Member revenues derived from User Member fees; a  
commission of ten (10) percent on any revenues from sale of "space" on its pages  
for commercials, advertisements; and a commission of fifteen (15) percent on the  
proceeds from the sale of Publishing Member content via Newshare. A electronic

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subscription to the Newshare UPDATE, an eMail for-Members-only newsletter containing the latest Web intelligence and electronic-publishing advice.

Commissions relating to NewshareAdshare(SM) Agency, a national rep firm responsible for soliciting electronic advertising, product information, demonstrations and awareness materials for listing or linking to the e-pages of Newshare Publishing Members will be forwarded for your approval where applicable.

OTHER Fees: ...

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g. Oliver, David; "TECHNICAL CONCEPT AND OPERATIONS: The Newshare Token Validation System (TVS);" Newshare Corp.; 4pg.; Copyright, 1995.

(a description of the TVS)

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h. "Newshare, Building a free market for digital information; Newshare Adshare Classified Marketplace;" Newshare Corp.; Copyright: 1995

Chicago Tribune Career Finder classifieds; CareerPath.com U.S. national job-finder database; Created from the print classified-advertising databases of six major U.S. newspapers: The Boston Globe, Chicago Tribune, Los Angeles Times, The New York Times, San Jose Mercury News and The Washington Post. Announced Oct. 18, 1995. Server often busy.

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i. "Delivering your share of the news: Newshare Custom Hypertext Services;" Newshare Corp.; Copyright 1995.

pg. 1: Fee Schedule: ...

pg. 2: Please submit a request for services to Newshare Corp. today. Call us at (413) 458-8001 prior to sending materials so we can get acquainted.

...

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j. "Newshare Common Topics Page;" Newshare Corp.; Copyright 1996

pg. 1: Here is a list of topics within the Newshare Resource Center. Within each topic area are links to World Wide Web (WWW) hypertext resources. Content provided by Newshare Publishing or Contributing members is always listed at the top of the list of links. ...

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k. "Clickshare – The Internet's Information Utility; Clickshare introduction for users;" Clickshare Service corp.; copyright 1998

pg. 1: . . . We expect you will soon be able to sign up for Clickshare where you already have a credit relationship. We're talking to many of these institutions. Until more are participating, to get started, sign up at Newshare, Clickshare's sister company. . . . Clickshare prototype publishers have included The Christian Science Monitor, American Reporter and Studio Briefing.

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l. Delivering your share of the news: Newshare LEVEL FOUR Advertising Rates and Data;" Newshare Corp.; Copyright 1995.

(Newshare Advertising Messages pertaining to rates and placement/description.)

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m. "Delivering your share of the news: Newshare w3 Member Index;" Newshare Corp.; Copyright 1995.

pg. 1: This is the Newshare Member Index. An easy guide to the "who's who" of the Newshare community. Look around you may find a friend or two who are already here. . .

=====  
n. "The Internet's first news brokerage(SM): Welcome to the Newshare Syndicate!" Newshare Corp.; Copyright 1996.

pg. 1: We are a broker of news and features on the Internet, delivering multimedia content from media companies and individual writers to users of World Wide Web. We are presently enrolling Contributing Members and Publishing Members who wish to provide content through our Newshare(SM) system of page-per-page viewing . . .

=====  
14. Again, to repeat section 9 above, examiner asserts that the information provided by applicant in the evidence does not provide a disclosure of a continuum of action over time (emphasis added), with specific dates and events that adequately disclose

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diligence of the inventors or their representative. Additionally, applicants argue that their conception of their invention was before 03 April 1996 (the application date of the Teper et al. patent). To receive benefit of a claimed priority, applicant should identify specific dates of invention for the continuum of action over time from conception to their application for patent (emphasis added), as required by the MPEP.

### ***Claim Rejections - 35 USC § 102***

15. Claims 1-82 were rejected in Paper #31 under 35 U.S.C. 102(b) based upon a public use or sale of the invention as evidenced by: "online privacy;" Red Rock Eater Digest; 02/08/2003, which discloses the article titled: "Clickshare(SM) alpha up; 'test drives' available;" Newshare Corp., 24 October 1995 (hereafter referred to as RedRock1).

RedRock1 discloses the invention in public use or on sale in this country, more than one year prior to the date of application for patent in the United States (pg. 1). This disclosure clearly anticipates applicants' invention. Additionally, applicants' arguments are not persuasive. Therefore, examiner maintains the rejection.

Claims 35-80 were rejected in Paper #31 under 35 U.S.C. 102(e) as being anticipated by Teper et al. (U.S. Patent No. 5,815,665). Applicants state in paper #8 at pg. 3 last paragraph that these claims are copied from Teper et al. Therefore, they are rejected as being unpatentable over prior art (Teper et al.). Applicants' arguments are not persuasive. Examiner maintains the rejection.



16. Claims 81 and 82 were rejected in Paper #31 under 35 U.S.C. 102(e) as being anticipated by Ferguson et al. (U.S. Patent No. 5,819,092). Applicants' arguments are not persuasive. Examiner maintains the rejection, as presented in the following paragraphs.

As per claim 81, Ferguson et al. discloses a plurality of separate user registration databases, a provider database, a settlement server, said user registration databases and said user account databases being independent and remotely located with respect to each other (Abstract; fig. 1 [170, 180, 107]; col. 9 lines 10-20).

As per claim 82, Ferguson et al. discloses storing users' identifications, and user account reference information in a database associated with the user; requesting the posting of a transaction to a user's account, without disclosing user identification to a posting party; receiving the request at a settlement server from the posting party; accessing a user registration database at a settlement server; communicating the request and a user identity to a corresponding one of a plurality of user account databases; and independently maintaining the user registration databases and the user account databases at remote locations (Abstract; fig. 1 [170, 180, 107]; col. 9 lines 10-20).

***Claim Rejections - 35 USC § 103***

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17. Claims 1, 3-7, 11-18, 20-24, and 28-34 were rejected in Paper #31 under 35 U.S.C. 103(a) as being unpatentable over Teper et al. (Patent No. 5,815,665).

Applicants' arguments are not persuasive. Examiner maintains the rejection, as stated below:

As per claim 1, Teper et al. teach:

- a mechanism for sharing client information and charges among a plurality of service providers (col. 6 lines 21-34; col. 8 lines 63-67; col. 9 lines 1-8);
- a client who is registered with one of the service providers and is allowed to access the resources of the other service providers (col. 5 lines 30-37 and 45-48; col. 6 lines 1-49);
- a settling means adapted to allow the system to settle accounts among service providers (col. 6 lines 4-13, 22-34 and 46-49);
- a sharing means adapted to allow the system to allow the providers to share users without requiring an open account for each user at each provider (col. 6 lines 38-67);
- a verification means including a token and an authentication server adapted to allow each provider to determine if a particular client is a member of the system, verify that the client has authenticated at his home provider, and determine this client's access or service privileges and criteria (col. 5 lines 30-37 and 45-48; col. 6 lines 53-61).

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As per claim 1, Teper et al. does not teach, explicitly, a payment means adapted to assure that the outside providers are then paid for that access through the system. However, Teper et al. teaches payment for these services by the user is to the Online Broker, who settles accounts billed by the Service Providers to authorized users (Col. 2 lines 32-38 and 62-65; col. 3 lines 19-41; col. 4 lines 22-27; col. 6 lines 4-13, 22-34 and 37-49). Also, Teper et al. (col. 15 lines 11-15) incorporates by reference Reeder, U.S. Patent No. 5,852,812, "Billing System For A Network" which teaches a payment means that relies on a centralized Online Broker site to handle billing matters for online services purchased by users from Service Providers. Payment for these services by the user is to the Online Broker, who pays Service providers for services billed by the Service Providers to users (Reeder, col. 6 lines 9-18). Therefore, it would have been obvious to one skilled in the computer and electronic commerce art at the time the invention was made to use the teachings of Teper et al. and Reeder to incorporate the payment function at an Online Broker to receive payment from the user for the services provided, and to pay the individual Service Providers accessed and used by the user (for their services during an online session) from the combined payment that the Online Broker receives from the user, because of the obvious advantages of time, expense and convenience of the user submitting payment information only once during an online session, the Online Broker processing only one payment (e.g., a credit card payment) from the user for the services received by the user during one online session from all Services Providers and the Online Broker, and the Service Providers not being required

to maintain complete user data files for access authorization and billing information for each user.

As per claim 3, Teper et al. teach one member of the system may instantaneously configure the form and substance of services or goods across a data network provided to different or unique clients in response to data about the client provided by the system along with the client's request for service (col. 3 lines 65-67; col. 4 lines 1-6).

As per claim 4, Teper et al. teach one member of the system may instantaneously determine whether or what type or form of service or goods across a data network to provide to different or unique clients of the system based upon data about the client provided along with the client's request for service (col. 3 lines 65-67; col. 4 lines 1-6).

As per claim 5, Teper et al. teach multiple members of the system may aggregate, transfer and share data about the clients of the system (col. 8, lines 63-67; col. 9 lines 1-15).

As per claim 6, Teper et al. teach a client of the system may request access to, review of, or purchase of resources or goods across a data network of members of the system on the basis of specific attributes of the client (fig. 2; col. 9 lines 9-15).

As per claim 7, Teper et al. does not teach explicitly a provider of service under the system provides a client's preference, pricing and service-class information to a common service point in exchange for an authenticatable token, which the service provider then provides to its client (fig. 4; col. 15 lines 21-51 and 57-61; col. 17 lines 64-67; col. 18 lines 1-17). However, Teper et al. does teach a provider of service under the system provides a client's preference, pricing and service-class information to a common service point in exchange for an authenticatable token, which the service provider then maintains for its client (fig. 4; col. 15 lines 21-51 and 57-61; col. 17 lines 64-67; col. 18 lines 1-17). In this configuration, the user connects to other service providers through its "home" service provider which passes the token to other service providers as the user accesses them through the auspices of its "home" service provider which maintains the user's token(s). This configuration is similar to that stated in the claim, with the principal difference being a "home" service provider (rather than the user directly) maintaining the user's token, and then connecting and transferring the token to selected service provider when the user attempts to connect to this selected service provider through his "home" service provider. The functionality of the connection for purposes of accessing service providers is the same. Therefore, it would have been obvious to one of ordinary skill in the computer and electronic commerce art at the time of the invention that the use of a token could simplify the connectivity process and provide some protection for the user's data provided to the user's "home" service provider by the user, because only selected components of the user's data (e.g.,

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name, address, or other data) need to be transmitted, while selected components of the data (e.g., user's credit card ID) need never be transmitted over unsecured communications paths.

As per claim 11, Teper et al. teach collecting and storing at a common service point discrete records of access by clients to resources and goods across a data network of multiple members of the service (col. 3 lines 31-41);

As per claim 12, Teper et al. teach discrete records are instantaneously sorted and stored in databases according to the identity of the service provider of the individual client whose activity resulted in the record being produced (col. 3 lines 41-44).

As per claim 13, Teper et al. teach collecting and aggregating records of financial charges for access to, review or acquisition of services or goods across a data network (col. 3 lines 41-44);

As per claim 14, Teper et al. teach said token is only "read" by the authentication server (Fig. 6; col. 3 lines 19-25; col. 15 lines 57-61; col. 16 lines 19-24).

As per claim 15, Teper et al. teach enabling an initiating Internet World Wide Web host to present in HyperText Markup Language (HTML) "hypertext links" which

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address services or goods available from multiple other receiving World Wide Web sites (fig. 4; col. 16 lines 48-59).

As per claim 16, Teper et al. teach a sequence means adapted for obtaining, transferring and maintaining among multiple network clients a unique alphanumeric sequence associated with a specific digital information resource or object (col. 3 lines 31-44).

As per claim 17, Teper et al. teach a sequence means adapted for obtaining, transferring and maintaining among multiple network clients and their server a dynamically updated record of funds encumbered by a network user for the purchase of a digital information resource or resources (col. 3 lines 35-41).

Claim 18 is written as a method and contains essentially the same limitations as claim 1; therefore, the same rejection is applied.

Claim 20 is written as a method and contains essentially the same limitations as claim 3; therefore, the same rejection is applied.

Claim 21 is written as a method and contains essentially the same limitations as claim 4; therefore, the same rejection is applied.

Claim 22 is written as a method and contains essentially the same limitations as claim 5; therefore, the same rejection is applied.

Claim 23 is written as a method and contains essentially the same limitations as claim 6; therefore, the same rejection is applied.

Claim 24 is written as a method and contains essentially the same limitations as claim 7; therefore, the same rejection is applied.

Claim 28 is written as a method and contains essentially the same limitations as claim 11; therefore, the same rejection is applied.

Claim 29 is written as a method and contains essentially the same limitations as claim 12; therefore, the same rejection is applied.

Claim 30 is written as a method and contains essentially the same limitations as claim 13; therefore, the same rejection is applied.

Claim 31 is a duplicate of claim 14 and contains the same limitations as claim 14; therefore, the same rejection is applied.

Claim 32 is written as a method and contains essentially the same limitations as claim 15; therefore, the same rejection is applied.

Claim 33 is written as a method and contains essentially the same limitations as claim 16; therefore, the same rejection is applied.

Claim 34 is written as a method and contains essentially the same limitations as claim 17; therefore, the same rejection is applied.

18. Claims 2 and 19 were rejected in Paper #31 under 35 U.S.C. 103(a) as being unpatentable over Teper et al. (Patent No. 5,815,665) as applied to claim 1 above, and further in view of Reeder (Patent No. 5,852,812) and Reuhl et al. (Patent No.



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5,873,069). Applicants' arguments are not persuasive. Examiner maintains the rejection, as stated below:

As per claim 2, Teper et al. does not explicitly teach the owner of goods may sell access to those goods across a data network such that the owner may instantaneously and simultaneously display across the network multiple differing prices of the same good or classes of goods depending upon the alternative pricing requirements of other clients of the system as transferred by the system (col. 4 lines 43-46; col. 5 lines 49-55; col. 6 lines 21-34; col. 8 lines 63-66). However, Reeder teaches

- a series of customers are linked through a gateway to a host data center (fig. 2 [12a, 12b, 12c, 14]; col. 5 lines 6-7);

- the host data center communicates with several outside services (col. 5 lines 11-12);

- the host data center also communicates with a billing services center that can provide invoices (col. 5 lines 26-27);

- the host data center can also communicate with remote data centers so that events that occur on the remote data centers can be communicated to the host data center for processing (col. 5 lines 44-47);

- content providers can provide services to customers attached to the host data center (col. 6 lines 5-7);

- content providers charge an additional fee for access to their services (col. 6 lines 9-10);

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-the owner of the host data center collects money from the customers for the services provided by the content provider, and the owner of the host data center pays royalties to the content provider (col. 6 lines 9-19).

Since Reeder is incorporated by reference into Teper et al., it would have been obvious to one skilled in the computer and commerce art at the time the invention was made to use the teachings of Teper et al. and Reeder to incorporate the capability that the owner of goods may sell access to those goods across a data network, because a data network provides access to a very large potential customer base for the purchasing of the owner's goods. Reeder and Teper et al. do not teach the owner may instantaneously and simultaneously display across the network multiple differing prices of the same good or classes of goods depending upon the alternative pricing requirements of other clients of the system as transferred by the system.

However, Reuhl et al. teaches an ability to automatically implement prices responses to market changes, on a product-by-product, market-by-market basis, and the system is suitably an enterprise -wide system and price changes are directed on a market-by-market basis (col. 6 lines 18-44). Therefore, it would have been obvious to one of ordinary skill in the computer art at the time of applicant's invention to modify the teachings of Teper et al. and Reeder with the teachings of Reuhl et al. to include the capability to sell access to goods across a data network such that the owner may instantaneously and simultaneously display across the network multiple differing prices of the same good or classes of goods depending upon the alternative pricing requirements of other clients of the system as transferred by the system, e.g.,

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geographic locations of the users, because market competition in specific market areas or the additional expenses of advertising, presentation, shipping, and handling costs may effect the costs to the owner of goods.

Claim 19 is written as a method and contains essentially the same limitations as claim 2; therefore, the same rejection is applied.

19. Claims 8-10 and 25-27 were rejected in Paper #31 under 35 U.S.C. 103(a) as being unpatentable over Teper et al. (Patent No. 5,815,665) as applied to claim 1 above, and further in view of Payne et al. (Patent No. 5,715,314) and Willens et al. (Patent No. 5,889,958). Applicants' arguments are not persuasive. Examiner maintains the rejection, as stated below:

As per claim 8, Teper et al. teach [system] which employs the Internet's Hyper-Text Transfer Protocol (HTTP) (col. 11 lines 34-45). Teper et al. does not teach [system] has appending means adapted to appending to or including in a Uniform Resources Locator, or in a Request/Response Header, a sequence of alphanumeric characters which includes said authenticatable token. However, Payne et al. teach [system] which employs the Internet's Hyper-Text Transfer Protocol (HTTP), and has appending means adapted to appending to or including in a Uniform Resources Locator, or in a Request/Response Header, a sequence of alphanumeric characters which includes said authenticatable token (col. 3 lines 19-22; col. 5 lines 26-46). Therefore, it would have been obvious to one of ordinary skill in the computer and

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electronic commerce art at the time of the invention to combine the teachings of Teper et al. and Payne et al. to teach a system which employs the Internet's Hyper-Text Transfer Protocol (HTTP), and has appending means adapted to appending to or including in a Uniform Resources Locator (URL), or in a Request/Response Header, a sequence of alphanumeric characters which includes said authenticatable token, because this provides security to the user information while providing the user the capability to make purchases from service providers over secure and unsecured communications links.

As per claim 9, Teper et al. teach an acceptance means by which a client's token is accepted by a system member from whom to receive services or goods across a data network, and is instantaneously submitted to the system's common service point (fig. 5 [80, 82, 84]; col. 15 lines 57-61; col. 16 lines 6-8 and 19-22;).

As per claim 10, Teper et al. does not teach utilizing the User Datagram Protocol. However, Willens et al. teach utilizing the User Datagram Protocol in conjunction with an access control system and process and firewall filtering of a server (col. 6 lines 10-20). Official Notice is taken that the User Datagram Protocol is known in the computer art. Therefore, it would have been obvious to one skilled in the computer and medical art to combine the teachings of Teper et al., Willens and known computer and electronic shopping art to incorporate the capability for implementing an acceptance means incorporating the User Datagram Protocol, because of the obvious advantages of very

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small data packet size requirements in an environment where data packet size affects the reliability and protocol requirements of the system.

Claim 25 is written as a method and contains essentially the same limitations as claim 8; therefore, the same rejection is applied.

Claim 26 is written as a method and contains essentially the same limitations as claim 9; therefore, the same rejection is applied.

Claim 27 is written as a method and contains essentially the same limitations as claim 10; therefore, the same rejection is applied.

### ***Response to Arguments***

20. Applicant's arguments filed 06/26/2003 have been fully considered but they are not persuasive. Applicants' arguments relative to application priority over the identified prior art have been addressed in the above sections of this Paper (see sections 3-5 above). Applicants have not demonstrated that due diligence was exercised in the time period from conception to reduction to practice of their invention. To receive benefit of a claimed priority, applicants should identify specific dates of invention for the continuum of action over time from conception to their application for patent.

### ***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Geoffrey Akers, primary whose telephone number is 703-306-5844. The examiner can normally be reached M-F from 6:30-5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



**DR. GEOFFREY R. AKERS, P.E.**  
**PRIMARY EXAMINER**

9/1/04